

REMARKS

This amendment is being refiled, inasmuch as it was not entered into the record after final. This amendment is also be refiled with an RCE so that the amendments and remarks of this amendment will be entered into the record and considered.

With regard to the advisory action, Applicants maintain that some of the claims have still not been fully considered on their merits. In particular, as clarified below, the merits of claims 29 and 30 have not been fully considered in the last amendment or advisory action. Instead, it appears that the Examiner feels that these dependent claims to add nothing new to the independent claims by the Examiner, such that the additional limitations specified by these claims have not been fully appreciated.

In the final Office Action, mailed May 27, 2005, claims 1-13 and 16-30 were all rejected.¹ Claim 1 and 16 are the only independent claims at issue, with claim 1 being directed to a method and claim 16 being directed to a corresponding computer program product. These independent claims have been amended by this paper to fix minor informalities, which do not affect the scope of the claims.

As previously clarified, the present invention is directed to embodiments in which a user is notified of events in a contextually sensitive manner.

The method recited in claim 1, for example, includes detecting an event which requires a notification be dispatched to the user at a designated device, an act of accessing a current context of the user corresponding to a user status at the designated device, and an act of identifying one of a plurality of possible notification methods to use in order to dispatch the notification to the

¹ Claims 1-12, 16-18, 20-23 and 26-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0023690 (Lohtia). Claims 13 and 19 were rejected under U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0023690 (Lohtia), as applied to claims 1-12, 14-18, 20-23 and 26-28, further in view of U.S. Publication No. 2003/0058096 (Shteyn). Claims 24-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2003/0023690 (Lohtia), as applied to claims 1-23 and 26-28 above, further in view of U.S. Publication No. 002/0002678 (Chow, et al). Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last response, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

designated device. Thereafter, it is determined, based upon the current context of the user with the designated device, which of the plurality of notification methods to use to provide the notification to the user at the designated device. The notification is then dispatched using the identified and contextually appropriate notification method.

As further clarified by some of the dependent claims, such as claims 29 and 30, the scope of the invention extends to embodiments in which the current context of a user includes at least one of a busy and not busy status at the designated device (claim 29) and a hands free status of the designated device (claim 30).

The foregoing embodiments, recited in claims 29 and 30, were not considered in the last office action. The office action stated that claims 29 and 30 were "rejected for the same reasons set forth in the rejection of claims 1-12 and 21-22" . . . because purportedly, 'the features of claims 29 and 30 can also be found in claims 1-12 and 21-22.' (See rejection no. 12 on page 5). However, Applicants strongly disagree. In particular, the features of claims 29 and 30, which clarify that the current context of a user comprises a busy status, a not busy status or a hands free status are not present in claims 1-12 and 21-22. It was for at least this reason that Applicants added new claims 29 and 30 in the last response, because these features were not specifically claimed, as discussed with the Examiner during the interview.

Another reason Applicants added new claims 29 and 30 is because the embodiments clarified by these new claims help to even further distinguish the invention from the art of record. In particular, the cited art, alone and in combination, fails to disclose or suggest a method for notifying a user of an event which requires a current context of the user to be identified, such as, for example, as recited in claim 29, wherein the context comprises a busy or not busy context, or as recited in claim 30, wherein the context comprises a hands free context. The cited art also fails to disclose or suggest that the appropriate notification method is used to notify the user of the event based on the context of the user, as claimed.

In fact, the art fails to even disclose or suggest any method wherein an appropriate notification method is identified from a plurality of available notification methods, based on a context of a user.

The primary reference, Lohtia, discloses a system and method wherein "In response to receiving a notification message for a user from a remote network site, the registration server

accesses the user profile and other information to determine at which of the devices of the user the user is present, if any. The notification server then selects one of the devices at which the user is present and sends a notification message for the user at the selected device. If notification is unsuccessful, notification is attempted at another one of the user's devices." Abstract. One benefit of Lohtia's invention is that it can help overcome the problem of redundant notifications described in Lohtia's background section.

Lohtia clearly fails, however, to describe or suggest any method in which the notification method is selected from a plurality of different notification methods and according to a detected contextual state of the user, as claimed.

In fact, Lohtia, does little more than detect whether a user acknowledges receipt of a notification at a device to subsequently determine whether the notification needs to be sent to another device.

This distinction was clearly explained during the last interview and in the last amendment. However, the Examiner has still rejected the claims based on what appears to be official notice that "it is well known in the art that when a called party's receiving device is in 'busy' status, an alternative method would be leaving a message in the device's associated message storage."

There are several problems with this line of reasoning. Initially, even if the examiner is correct, this presumption still fails, even in combination with Lohtia, to disclose or suggest every claim element recited in the claims, and therefore also fails to establish a *prima facie* case of obviousness. In particular, in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added).

Applicants respectfully submit, however, that the art and the Examiner's assertion of Official Notice still fail to teach or suggest all of the claim limitations for at least failing to disclose or suggest the claimed "identifying a plurality of possible notification methods to use." The cited art and the Examiner's statement also fail to suggest or disclose the act of "determining, based on the current context of the user with the designated device, which of the plurality of notification methods to use to provide the notification to the user at the designated device."

Instead, Lohtia merely helps identify which device to send a notification to and the Examiner's statement only indicates that when a device is busy that an alternative method can be used to leave a message. Leaving a message as an alternative, however, is not what is claimed. Initially, the Examiner has not indicated what "leaving the message" is "an alternative" for. Is the message an alternative to not leaving a message? Or, is the message an alternative to providing the notification? Either way, this still falls short of teaching or suggesting that a plurality of notification methods are identified, such as, for example, visual and audio notification methods (see claim 5), and that one of the plurality of methods is determined to be the appropriate notification method to use based on the current context of the user with the device that the notification is to be sent to.

Furthermore, even if the system of Lohtia, in combination with the Examiner's official notice, taught each of the claim elements, which they don't, there needs to be a motivation for combining the references, which comes from the art and not from Applicant's own invention.

In particular, Applicants remind the Examiner that the "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS." MPEP § 2143.01. This is true even all of the elements are taught by the cited art, which they aren't in this case.

Furthermore, Applicants also point out that with regard to any art or official notice that might be combined by the Examiner in any future rejection of this case, that the motivation for making such a combination must come from the references themselves, not the Applicant's own application, otherwise such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure." MPEP 2143. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)(emphasis added).

In the present case, however, there is no motivation provided by Lohtia to suggest or motivate one skilled in the art to identify one of a plurality of different notification methods to use to send a notification to a user and based on the context of the user at the user's device. Instead, Lohtia merely wants to identify where a user is so that a notification can be sent to one of the user's devices where the user is at and so as to avoid sending redundant notifications to each of the user's devices.

Although the forgoing remarks have focused primarily on the independent claims, it will be appreciated that, for at least the foregoing reasons, all of the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. For example, the other cited art, Chow and Shteyn, was only cited in rejecting some of the dependent claims and will not, therefore, be addressed in detail at this time. However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should the need arise, including any official notice.

For at least the forgoing reasons, Applicants respectfully submit that the pending claims are now in condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 19 day of December, 2005.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant

Customer No. 47973

RDN:JCJ:ppa
W:\13768\233\PPA0000002012V001.DOC